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| 10/529,161 | 02/27/2006 | Christian Mueller | ITC-331US | 2080 |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,161

Applicant(s)

MUELLER, CHRISTIAN

Examiner

F. Daniel Lopez

Art Unit

3745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/86)
Paper No(s)/Mail Date 3/24/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Specification

The disclosure is objected to because of the following:

Page 12 paragraph 1 states that "if test head 3 is pressed down..., the pressure in the holding compartment 23 increases. Pressure control device 26 recognizes this pressure increase and diverts fluid out of fluid-holding compartment 23 until the original target value is reached". It is understood that as the pressure in the compartment increases, there is fluid flow out of the compartment and into the lines connected to the valves 28, 29 and 30. Since the pressure in the lines is held constant by regulator 28, a flow out of the compartment into the lines will cause an increase in pressure in the lines. There is no mechanism shown for decreasing this pressure. Therefore, it is unclear how the fluid is diverted and how the pressure is reduced back to the target pressure.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a lifting device with an outer cylinder, does not reasonably provide enablement for "a pressure regulator for maintaining a pressure within said fluid compartment such that the test head may be suspended in a substantially weightless position" (e.g. claim 1 line 7-9). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. As per the discussion above, there is no mechanism to allow the pressure to be decreased when moved down; and thereby the test head is not suspended in a substantially weightless manner.

Claims 1-5, 11 and 14-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 8 "may be" is not a positive limitation, and should be replaced by --is--.

In claim 11 line 2 "applying an external force" seems to be the same limitation as step b of claim 9 (line 4-5).

In claim 14 line 13 "can slide" line 13-14 "can be regulated" and line 15 "can be brought" are not positive limitations.

In claim 16 and 19 line 2 "can be adjusted" is not a positive limitation.

Claims not specifically mentioned are indefinite, since they depend from one of the above claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 and 19-21 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Slocum et al. Slocum et al. discloses a positioning apparatus comprising a lifting device for raising and lowering a test head and including a threaded drive mechanism (including 410, 462) operated by a drive apparatus, wherein, in one embodiment (fig 4A), the drive apparatus (406) is mounted to a base (404), with no mention of an outer cylinder; and in a second embodiment (fig 4B), the drive apparatus (456) is raised and lowered by the lifting device; and an outer cylinder (470) is mounted to a base (404), with a pressure regulator (e.g. column 7 line 12-13) maintaining a pressure in a fluid compartment (472) defined by the outer cylinder and a piston, such that the test head is suspended in a substantially weightless vertically adjustable position, for providing compliance to the system along the vertical axis (column 7 line 21-22). In the second embodiment, the outer cylinder is not above nor raised or lowered by the lifting device, and in the first embodiment, there is no discussion of an outer cylinder. One having ordinary skill in the positioning apparatus art would recognize that the first embodiment has an outer cylinder device, above and moved by the lifting device, but that it is not described until

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the second embodiment, thereby making the outer cylinder device inherent. If not, it would have been obvious at the time the invention was made to one having ordinary skill in the art to lift an outer cylinder with the lifting device of the first embodiment, which includes a pressure regulator maintaining a pressure in a fluid compartment defined by the outer cylinder and a piston, wherein the outer cylinder is above the lifting device, for providing compliance to the system along the vertical axis.

The elements of the positioning device include a hollow lifting rod (part of 160), an inner cylinder (468) and there is a position sensor for detecting vertical position of the test head (column 2 line 46-48).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-17 and 19-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Slocum et al. Slocum et al discloses a second embodiment with all the elements of claims 1-17 and 19-21, as discussed above; but does not disclose that the outer cylinder is above and moved by the lifting device.

Slocum et al teaches, for a first embodiment, that the drive apparatus can be fixed to the based, instead of being above and moved by the lifting device.

Since the embodiments of Slocum et al are functionally equivalent in the positioning art; it would have been obvious at the time the invention was made to one having ordinary skill in the art to locate the drive apparatus of the second embodiment of Slocum et al such that it is fixed to the base, thereby locating the outer cylinder above and moved by the lifting device, as taught by the first embodiment of Slocum et al, since one having ordinary skill in the art would have been able to carry out such a substitution and the resulting combination would predictable work in the same manner.

Conclusion

Claims 18 and 22-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is 571-272-4821. The examiner can normally be reached on Monday-Thursday from 6:00 AM -4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on 571-272-4820. The fax number for this group is 571-273-8300. Any inquiry of a general nature should be directed to the Help Desk, whose telephone number is 1-800-PTO-9199.

/F. Daniel Lopez/

F. Daniel Lopez
Primary Examiner
Art Unit 3745
May 20, 2008